REMARKS

In the December 15, 2003 Office Action, of pending claims 1-24, claims 1-24 were rejected under 35 U.S.C. §103(a). By this Amendment, claim 1 is amended, leaving claims 1-24 pending with claims 1, 9 and 15 being independent.

I. Request for Entry of Amendment

Applicant respectfully requests entry of the proposed amendment to claim 1. The proposed amendment incorporates subject matter into claim 1 which was recited in previously pending claims. Applicant therefore believes the amendment raises no new issues, and requests entry of the amendment.

II. Rejection of Claims 1-4 Under 35 U.S.C. §103(a) over the L'Esperance, Warner, and Yu Patents

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,718,418 to L'Esperance, Jr. in combination with U.S. Patent No. 4,903,695 to Warner et al. and U.S. Patent No. 6,264,665 to Yu et al. The Action contends that the combination of these three references renders obvious all of the elements of these claims.

Applicant respectfully traverses this rejection because the combination of the L'Esperance, Warner and the Yu patents does not disclose or suggest all the elements of independent claim 1. In particular, the proposed combination does not disclose or suggest the step of "controlling *a robot having a lens dispenser* to insert said intracorneal blank proximate to at least one of said first and second internal surfaces." This step of controlling a robot having a lens dispenser allows highly accurate and controllable placement of a lens into an eye.

A. The L'Esperance Patent

The L'Esperance patent discloses using a laser to modify the external curvature of the cornea to achieve a change in optical properties. The patent discusses implanting a donated cornea at Col. 5, line 45 through Col. 6, lines 21. In that passage, the L'Esperance patent does not disclose or suggest using a robot, nor does it disclose or suggest a lens dispenser.

Consequently, L'Esperance does not disclose or suggest the limitation of "controlling *a robot having a lens dispenser* to insert said intracorneal blank proximate to at least one of said first and second internal surfaces."

B. The Warner patent

The Warner patent discloses forming a lenticule flap in the cornea. After the flap is formed, a controlled tissue-ablating laser radiation is applied to the freshly cut part of the cornea that is left after severing the lenticule. The Warner patent does not disclose, teach or suggest inserting an inlay or a lens under a flap. Consequently, the Warner patent does not suggest the limitation of "controlling *a robot having a lens dispenser* to insert said intracorneal blank proximate to at least one of said first and second internal surfaces."

C. The Yu patent

The Yu patent teaches using a stereotactic manipulator and/or a tool transition table to position a tool. The tip of the tool is positioned at a desired location within the eye and subsequently worked or operated to perform ultramicrosurgery. The Yu patent primarily discusses performing retinal surgery, and does not mention implanting a lens. Because the Yu patent does not disclose or suggest implanting a lens, the Yu patent also does not disclose or suggest the limitation of "controlling *a robot having a lens dispenser* to insert said intracorneal blank proximate to at least one of said first and second internal surfaces."

In sum, none of the three cited patents discloses or suggests "controlling *a robot having a lens dispenser* to insert said intracorneal blank proximate to at least one of said first and second internal surfaces." Since none of the three patents discloses or suggests "controlling *a robot having a lens dispenser* to insert said intracorneal blank proximate to at least one of said first and second internal surfaces," the proposed combination of the three patents likewise fails to disclose or suggest the recited limitation.

III. Rejection of Claims 1 and 5-8 Under 35 U.S.C. §103(a) over the L'Esperance, Warner, and Yu Patents and the Salz Reference

Claims 1 and 5-8 were also rejected under 35 U.S.C. §103(a) as being unpatentable over the L'Esperance patent in combination with the Warner and Yu patents and further in view of the publication Corneal Laser Surgery edited by Salz ("Salz reference").

For substantially the same reasons discussed above, Applicant respectfully traverses this rejection. The Salz reference relates to corneal laser surgery. The Salz reference does not disclose or suggest "controlling *a robot having a lens dispenser* to insert said intracorneal blank proximate to at least one of said first and second internal surfaces." Thus, none of the four cited references discloses or suggests the quoted limitation, and the combination of the four references likewise fails to disclose or suggest the quoted limitation.

In view of the fact that none of the four cited references, alone or in combination, suggests "controlling *a robot having a lens dispenser* to insert said intracorneal blank proximate to at least one of said first and second internal surfaces," Applicant submits that independent claim 1, and its respective dependent claims 2-8 are allowable over the cited prior art. Notice to that effect is respectfully requested.

IV. Rejection of Claims 9-14 and 15-21 Under 35 U.S.C. §103(a) over the L'Esperance, Warner, and Yu Patents, the Salz Reference, and the Galvanauskas Patent

Claims 9-14 and 15-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the L'Esperance patent in combination with the Warner and Yu patents and Salz reference further in view of U.S. Patent No. 6,208,458 to Galvanauskas et al. The Examiner alleges that the Galvanauskas patent teaches using ultrashort pulses to form corneal flaps.

Applicant respectfully traverses this rejection for reasons similar to those discussed above. Independent claim 9 recites, among other things, a method including the step of "controlling *a second automated device to position an intracorneal lens* on an internal corneal surface." Independent claim 15 recites, among other things, "*a lens dispensing device coupled to a second robotic arm and adapted to position a lens on an internal surface of the cornea.*" As discussed above, none of the cited references, alone or in combination, disclose an automated

device for positioning an intracorneal lens on an internal corneal surface, or a lens dispensing device coupled to a second robotic arm. Consequently, these claims are allowable.

V. Conclusion

In view of the above amendments and remarks, it is believed that the above-identified application, with claims 1-24 pending, is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the number indicated below.

Respectfully submitted,

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